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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,136	03/16/2004	Conrado Blasco Allue	550-531	9235

23117   7590   10/04/2006

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER
IQBAL, NADEEM

ART UNIT	PAPER NUMBER
2114	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr>
<td rowspan="2">Office Action Summary</td>
<td>Application No.
10/801,136</td>
<td>Applicant(s)
ALLUE ET AL.</td>
<td></td>
</tr>
<tr>
<td>Examiner
Nadeem Iqbal</td>
<td>Art Unit
2114</td>
<td></td>
</tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 March 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,10,12-15 and 21* is/are rejected.

7)☐ Claim(s) *5-9,11,16-20 and 22* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Double Patenting

1.   Claims 1-22 of this application conflict with claims 1-11, & 15-25 of Application No. US

2005/0246585. 37 CFR 1.78(b) provides that when two or more applications filed by the same

applicant contain conflicting claims, elimination of such claims from all but one application may

be required in the absence of good and sufficient reason for their retention during pendency in

more than one application. Applicant is required to either cancel the conflicting claims from all

but one application or maintain a clear line of demarcation between the applications. See MPEP

§ 822.

2.   A rejection based on double patenting of the "same invention" type finds its support in
the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and
useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same
invention," in this context, means an invention drawn to identical subject matter. See *Miller v.
Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957);
and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

        A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by
canceling or amending the conflicting claims so they are no longer coextensive in scope. The
filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35
U.S.C. 101.

3.   Claims 1-22 provisionally rejected under 35 U.S.C. 101 as claiming the same invention

as that of claims 1-12, & 15-25 of copending Application No. US 2005/0246585. This is a

<u>provisional</u> double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6.   Claims 1-4, 10, 12-15, & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mason et al., (U.S. Patent number 5926640).

7.   As per claim 1, Mason teaches (col. 2, lines 1-3) a method for decreasing power consumption in a computer system. The system includes a central processing unit in a low power consumption mode. He also teaches (col. 2, lines 5-7) returning the processing unit to normal power consumption mode. He thus teaches a data processing circuit operable to execute program instructions including operational mode and power down mode. With reference to data processing circuit returns to the operational mode from the power down mode, the diagnostic circuit prevents execution of further program instructions until released by the diagnostic circuit. He teaches (col. 4, lines 52-55) a signal line CPU_PWR_EN connected to a power supply and means for reducing its output voltage to a level sufficient to stop the CPU from executing instructions. He does not explicitly disclose a diagnostic circuit operable to perform operations upon the processing circuit. He teaches (col. 5, lines 5-7) operating system software that

determines that the CPU should be placed into the low power consumption mode, it de_ asserts

signal line CPU_PWR_EN. It would have been obvious to a person of ordinary skill in the art at

the time the invention was made to realize that the operating system software provides the

functionality of a diagnostic circuit, since it determines the CPU status and determines that the

CPU should be placed into the low power consumption mode.

8.   As per claims 2 & 3, He teaches (col. 5, lines 5-7) operating system software that

determines that the CPU should be placed into the low power consumption mode, it de_ asserts

signal line CPU_PWR_EN and also teaches (col. 4, lines 52-55) a signal line CPU_PWR_EN

connected to a power supply and means for reducing its output voltage to a level sufficient to

stop the CPU from executing instructions.

9.   As per claim 4, With reference to mode that does not permit program execution to be

halted. He teaches (col. 8, lines 64-67).

10.   As per claim 10, He teaches (col. 5, lines 5-7) operating system software that determines

that the CPU should be placed into the low power consumption mode, it de_ asserts signal line

CPU_PWR_EN.

11.   As per claim 12, Mason substantially teaches the claimed invention as disclosed related

to claim 1 above. He also teaches (col. 2, lines 5-7) returning the processing unit to normal

power consumption mode. He thus teaches a data processing circuit operable to execute program

instructions including operational mode and power down mode. With reference to data

processing circuit returns to the operational mode from the power down mode, the diagnostic

circuit prevents execution of further program instructions until released by the diagnostic circuit.

He teaches (col. 4, lines 52-55) a signal line CPU_PWR_EN connected to a power supply and

means for reducing its output voltage to a level sufficient to stop the CPU from executing

instructions. He does not explicitly disclose performing diagnostic operations upon the

processing circuit. He teaches (col. 5, lines 5-7) operating system software that determines that

the CPU should be placed into the low power consumption mode, it de_ asserts signal line

CPU_PWR_EN. It would have been obvious to a person of ordinary skill in the art at the time

the invention was made to realize that the operating system software provides the functionality of

a diagnostic circuit, since it determines the CPU status and determines that the CPU should be

placed into the low power consumption mode.

12.   As per claims 13 & 14, He teaches (col. 5, lines 5-7) operating system software that

determines that the CPU should be placed into the low power consumption mode, it de_ asserts

signal line CPU_PWR_EN and also teaches (col. 4, lines 52-55) a signal line CPU_PWR_EN

connected to a power supply and means for reducing its output voltage to a level sufficient to

stop the CPU from executing instructions.

13.   As per claim 15, With reference to mode that does not permit program execution to be

halted. He teaches (col. 8, lines 64-67).

14.   As per claim 21, He teaches (col. 5, lines 5-7) operating system software that determines

that the CPU should be placed into the low power consumption mode, it de_ asserts signal line

CPU_PWR_EN.
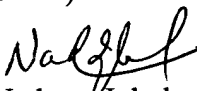
Allowable Subject Matter

15.   Claims 5-9, 11, 16-20, & 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nadeem Iqbal whose telephone number is (571)-272-3659. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Baderman can be reached on (571)-272-3644. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nadeem Iqbal
Primary Examiner
Art Unit 2114

NI